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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/781,527	02/17/2004	Edward R. Katz	741501-1053	2433

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EXAMINER

WENDELL, MARK R

ART UNIT	PAPER NUMBER
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3609

MAIL DATE	DELIVERY MODE
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05/01/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/781,527

Applicant(s)

KATZ, EDWARD R.

Examiner

Mark R. Wendell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 2/17/04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 February 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “plurality of ribs” discussed in claims 6 and 7, along with the main protective sleeve of claim 10 must be shown or the features canceled from the claims. No new matter should be entered.
2. The drawings are objected to because figures 1 and 3 are inconsistent with respect to the minor flap (22) as shown below.

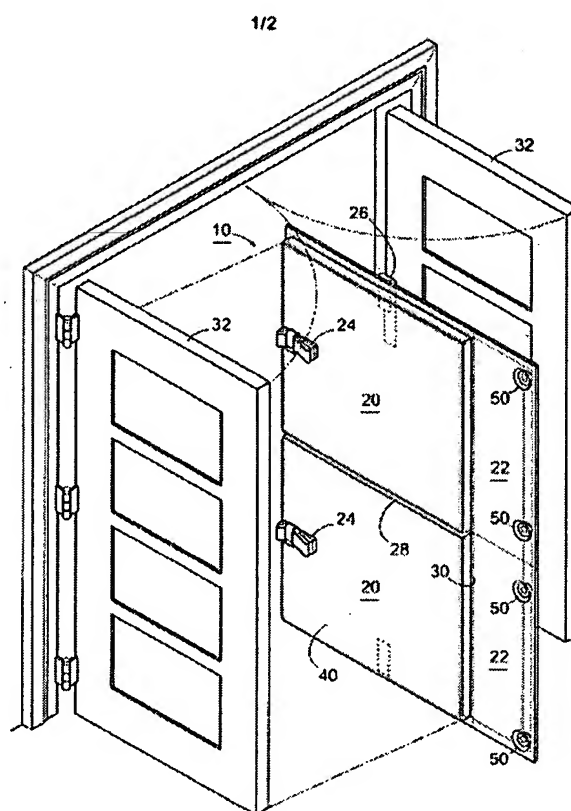


FIG 1

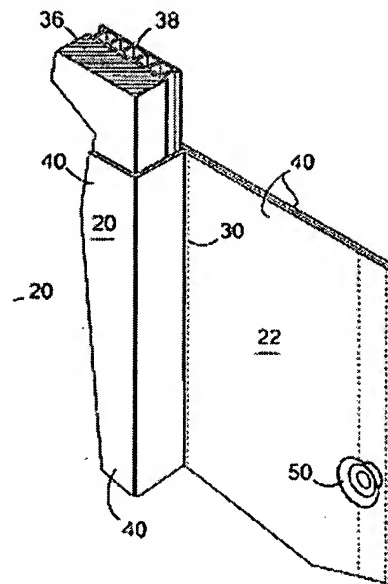


FIG 3

In Figure 1 it looks as if the minor flap is large and spans the entire area of the main section (20). Figure 3 illustrates the minor flap to be a small arm or attachment to the rigid sheet.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for

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consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim (lines 5-6) states "at least one rigid sheet in juxtaposition having a main horizontal fold line with a sheet on each side of the horizontal fold line." "Sheet" is an ambiguous term and it is not clear, in the context of the claim, what exactly is on each side of the horizontal fold line (i.e. main section, minor flap, or main protective sleeve). Appropriate correction is required.

5. Regarding claims 1-18, claim 1 (line 5) states "at least one rigid sheet in juxtaposition having..." It is not clear with respect to what the "at least one rigid sheet" is in juxtaposition with.

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6. Regarding claim 4, it states "wherein the main section has one rigid sheet on each side of the horizontal fold line." This is the same invention claimed in claim 1, part (a), lines 4-6.

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 6, 7, and 10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contain subject matter that was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification does not disclose any language about ribs, their function, or how they are made.

9. Regarding claim 8, the term "significant" in claim 8 is a relative term that renders the claim indefinite. The term "significant" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

10. Regarding claim 10, neither the specification nor the drawings show or describe how the main protective sleeve is fastened to or works in conjunction with the main protection material.

Double Patenting

11. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

12. Claim 1 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6718706. Although the conflicting claims are not identical, they are not patentably distinct from each other because the terms "at least one" from the application encompass the term "two" of patent '706, essentially trying to broaden a patented claim. In the context of claim 1 of the application, "at least one" is by definition "two" given the information "a horizontal fold line with a sheet on each side." Part (b) of claim 1 of the application is again broadening claim 1 of '706 by changing "a cushioning material" to "at least one material."

13. Claims 2, 3, and 5 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over U.S. Patent No. 6718706. Regarding claim 2, it depends on claim 1 of the application and further limits the claim by claiming the exact additional structure in Claim 2 of '706.

14. Regarding claim 3, it depends on claim 1 of the application and further limits the claim by claiming the exact additional structure in claim 3 of '706.

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15. Regarding claim 5, it depends on claim 1 of the application and further limits the claim by claiming the exact additional structure in claim 5 of '706.

16. Regarding claims 6 and 7, a plurality of ribs (Claim 6) in juxtaposition to each other and being perpendicular to one another (Claim 7) is claimed. These claims, if combined, are exactly what are claimed in claim 5 of '706.

17. Regarding claim 8, the sole difference between claim 8 of the application and claim 8 of '706 is the word "significant" that appears within claim 8 of the application. The word "significant" adds no new, specific structure to the patented claim.

18. Regarding claims 9, it depends on claim 1 of the application and further limits the claim by claiming the exact additional structure in Claim 9 of '706.

19. Regarding claim 10 depends on claims 1 and 9 of the application and further limits the claims by claiming the exact additional structure in Claim 10 of '706.

20. Regarding claim 11, the additional structure claimed in claim 11 of the application, "two sheets of material in juxtaposition to each other," to one of ordinary skill in the art would read on claim 11 of '706, "a minor protective sleeve enclosing the minor protection material."

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21. Regarding claims 13-18, the additional structures claimed in claims 13-18 of the application correspond identically to the additional structures claimed within claims 13-18 of '706. Therefore, since they depend on claim 1, which was rejected based on nonstatutory obviousness-type double patenting, and the additional structures are identical to those of '706.

22. Claim 4 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 4 of U.S. Patent No. 6718706 in view of Claim 4 of U.S. Patent No. 5813172.

Katz (US Patent 6718706) claims (Claim 4) "two rigid sheets on each side of the horizontal fold line in juxtaposition to each other." Katz does not teach having only one rigid sheet on each side of the horizontal fold line.

However, McNally (US Patent 5813172) claims (Claim 1), "having a border along edges of said pad, each border having a top side and bottom side." Also, referring to Figure 3 of '172, there is one rigid sheet on each side of the fold line.

Based upon what size or shape object one would like to construct or protect, it would be obvious to one of ordinary skill in the art to have one rigid sheet on each side of a horizontal fold line, rather than two.

23. Claim 12 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 10 of U.S. Patent No. 6718706 in view of U.S. Patent No. 5813172.

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Katz (US Patent 6718706) teaches the entire structure of claim 1, "a portable device for protecting the surfaces of an entryway." Katz does not directly disclose the main protective sleeve being constructed of the same material of the minor flap.

However, McNally (US Patent 5813172) discloses that the entire structure, including all sides, is made of the same material (vinyl).

It would be obvious to one of ordinary skill in the art, with the motivation of consistency and cost-effective construction, to have the main protective sleeve constructed from the same material as the minor flap.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. McQuown (US Patent 1126243) teaches improvements to freight car shipping attachments. Gilkey (US Patent 1719364) teaches a cost-effective casket protective cover. Katz (US Patent 6381910) teaches a protection device for use with elevator door jamb panels and entryway doors to protect the surfaces of these panels and doors from sustaining damage from collisions with moving equipment, building materials and furniture. DeRosa (US Patent 5937458) teaches protective padding for use within a baby crib.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark R. Wendell whose telephone number is (571) 270-3245. The examiner can normally be reached on Mon-Fri, 7:30AM-5PM, Alt. Fri off, EST.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Victor Batson can be reached on (571) 272-6987. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Victor Batson
Supervisory Patent Examiner
Art Unit 3609

MW
April 30, 2007